

## ARGUMENTS / REMARKS

Claims 1-16 are pending in the application. Claims 7, 10, 13 and 16 have been withdrawn. Claims 4 and 6 have been cancelled.

As set forth in the above listing of claims, each of independent claims 1 and 2 has been amended. Dependent claims 3 and 5 have also been amended.

The Examiner has rejected each of claims 1-6, 8, 9, 11, 12, 14 and 15 as being unpatentable under 35 U.S.C. §102(b) or 35 U.S.C. §103. A discussion of the various cited references is provided separately below.

### **A. Rejection of Claims 1, 3-4 and 11 under Boulet.**

Claims 1, 3, 4 and 11 have been rejected under 35 U.S.C. §102(a) as being anticipated by French Patent No. 1.013.219 issued to Boulet. Claim 1 is an independent claim directed to a pen holder. Claims 3, 4 and 11 each depend from claim 1.

In support of claim 1, Applicant would first show that claim 1 has been amended to clarify that the body receives separate writing instruments in recesses through openings on opposing ends of the body. The recesses are dimensioned to receive writing instruments of different radial sizes. In contrast, Boulet does not show a single device having these combined features.

Figures 1-3 of Boulet demonstrate a device in one embodiment having two recesses. However, the openings for these recesses are central to the body of the device, and are not on opposing ends. The Examiner has stated that the two recesses are of "unequal dimensions." Applicant is unable to clearly discern this asserted feature from Figure 1. Moreover, it has been held that relative dimensions in drawings are not to be deemed as prior art unless delineated in the specification of the cited reference. *See, e.g., Nystrom v. Trex Co.*, 71 USPQ2d 1241, 1250 (Fed. Cir. 2004) (patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is "silent on the issue.") (citing *Hockerson-Halberstadt, Inc. v. Avia Group International, Inc.*, 55 USPQ2d 1487 (Fed. Cir. 2000)). Either way, the drawings of Boulet do not clearly show a pen holder receiving two different writing instruments of different radial dimensions.

In an alternate embodiment, Figure 6 of Boulet shows a device having two recesses, and having openings in opposing ends. However, these recesses appear to be of identical dimensions. A user would not, for example, be able to removably insert a ball point pen in one recess and a larger board-marker in the other.

Claim 3 has been amended to specifically provide that the first recess is sized to receive a pen, while the second recess is sized to receive a marker. Typically, a marker such as would be used to write on a board or large piece of paper has a larger radial dimension than a pen.

Because claim 1 is allowable over Boulet, Applicant respectfully submits that dependent claims 3 and 11 are likewise allowable.

Claim 4 has been cancelled.

#### **B. Rejection of Claims 2,5, 6 and 12 under Boulet.**

Claims 2, 5, 6 and 12 have also been rejected under 35 U.S.C. §102(a) as being anticipated by French Patent No. 1.013.219 issued to Boulet. Claim 2 is an independent claim directed to a pen holder. Claims 5, 6 and 12 each depend from claim 2.

In support of claim 2, Applicant would first show that claim 2 has been amended to clarify that the body has a plurality of receives for receiving separate writing instruments through openings on opposing ends of the body. In addition, at least two of the recesses are dimensioned to receive writing instruments of different radial sizes. In contrast, Boulet does not show a single device having these combined features.

Figures 1-3 of Boulet demonstrate a device in one embodiment having two recesses. However, the openings for these recesses are central to the body of the device, and are not on opposing ends. The Examiner has stated that the two recesses of Figure 1 are of "unequal dimensions." As noted above, Applicant is unable to clearly discern this asserted feature from Figure 1. Applicant respectfully submits that the drawings of Boulet do not clearly show a pen holder receiving two different writing instruments of different radial dimensions.

In an alternate embodiment, Figure 7 of Boulet shows a device having three recesses, and having openings in opposing ends. However, these recesses appear to be of identical dimensions. A user would not, for example, be able to removably insert a ball point pen in one recess and a larger board-marker in the other.

Claim 5 has been amended to specifically provide that the first recess is sized to receive a pen, while the second recess is sized to receive a larger marker. Typically, a marker such as would be used to write on a board or large piece of paper has a larger radial dimension than a pen.

Because claim 2 is allowable over Boulet, Applicant respectfully submits that dependent claims 5 and 12 are likewise allowable.

Claim 6 has been cancelled.

#### **C. Rejection of Claims 1 and 4 under Adams.**

Claims 1 and 4 have been rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,238,459 issued to Adams. Claim 1 is an independent claim directed to a pen holder; claim 4 depends from claim 1.

Adams provides a clamp for holding decorative lights "and other objects." The specification does mention "pens, pencils and markers" as the other objects. However, the clamp of Adams does not have openings in opposing ends of the body as claimed in amended claim 1; rather, the openings are central to the body. Having openings facing outwardly of the body makes the device of the present invention far more functional in that a pen or a marker can be quickly inserted or released by lateral force.

Dependent claim 4 has been cancelled.

#### **D. Rejection of Claims 2 and 6 under Adams.**

Claims 2 and 6 have been rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,238,459 issued to Adams. Claim 2 is an independent claim directed to a pen holder; claim 6 depends from claim 2.

As noted, Adams provides a clamp for holding decorative lights "and other objects." The specification again mention "pens, pencils and markers" as the "other objects." However, the clamp of Adams does not have openings in opposing ends of the body as claimed in amended claim 2; rather, the openings are central to the body. Having openings facing outwardly of the body again makes the device of the present invention far more functional so that a pen or a marker can be quickly inserted or released by lateral force.

Dependent claim 6 has been cancelled.

**E. Rejection of Claims 14 and 15 over Boulet in view of Mullins.**

Claims 14 and 15 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Patent No. 6,276,854 issued to Mullins. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Boulet, dependent claims 14 and 15 are likewise allowable.

**F. Rejection of Claims 14 and 15 over Adams in view of Mullins.**

Claims 14 and 15 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Patent No. 6,276,854 issued to Mullins. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Adams, dependent claims 14 and 15 are likewise allowable.

**G. Rejection of Claims 8 and 9 over Boulet in view of Chau.**

Claims 8 and 9 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Patent No. 6,238,459 issued to Chau. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Boulet, that dependent claims 8 and 9 are likewise allowable.

**H. Rejection of Claims 8 and 9 over Adams in view of Chau.**

Claims 8 and 9 have also been rejected under 35 U.S.C. §103(a). The Examiner has cited Adams in view of U.S. Patent No. 6,238,459 issued to Chau. These are dependent claims which depend from independent claims 1 and 2, respectively.

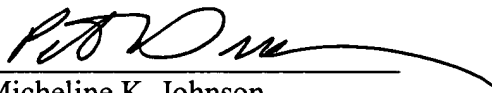
Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Adams, that dependent claims 8 and 9 are likewise allowable.

## CONCLUSION

Having addressed all issues set out in the Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed. Applicant states that arguments made in connection with one set of claims should not be construed as, and are not intended to be, limitations for other sets of claims herein.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

Respectfully submitted,



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